

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 7, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Small Fry Beginnings, LLC

v.

Evelyn Williams English
—

Opposition No. 91269989
—

Gregg A. Paradise of Lerner, David, Littenberg, Krumholz & Mentlik, LLP,
for Small Fry Beginnings, LLC.

Andrea H. Evans of The Law Firm of Andrea Hence Evans, LLC,
for Evelyn Williams English.

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Before Lykos, Heasley, and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Evelyn Williams English (“Applicant”) seeks registration on the Principal Register
of the mark BRAINY ACTS (in standard characters) for

Educational publications, namely, educational learning
cards, flash cards, activity cards, workbooks, textbooks,
activity books, story books, puzzle books, printed puzzles,
teacher guides, manuals, posters and educational booklets

in the field of Early Childhood Development, in
International Class 16.¹

Small Fry Beginnings, LLC (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d), 15 U.S.C. § 1052(d). Opposer pleads ownership of six registered BRAINY-inclusive marks, and common law rights thereto, for, among other things, DVDs, children’s books and children’s toys.² This includes the BRAINY BABY mark (in standard characters), which is registered on the Principal Register for inter alia “Children’s activity books; Children’s books; Children’s interactive educational books,” in International Class 16

¹ Application Serial No. 90160993 was filed on September 4, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

² Notice of Opposition, paras. 2-7 (1 TTABVUE 6-8). Opposer also pled the following registered marks: BRAINY BABY (Reg. No. 4002221); BRAINY BOX (Reg. No. 5700315); BRAINY KIDS (Reg. Nos. 4643740 and 4643738); and MY BRAINY BABY (Reg. No. 5001344). Opposer submitted plain copies of its pleaded registrations with its Notice of Opposition, which, by themselves, are insufficient to be received in evidence and made part of the record. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1); *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *9 (TTAB 2022) (A paper copy of a certificate of registration that is not specially prepared by the USPTO, or accompanied by USPTO electronic records, is commonly referred to as a “plain” copy, and plain copies do not provide current status and ownership and “generally are not sufficient to make a registration of record.”). While there are exceptions to this rule, they do not apply here, as the “youngest” registration attached to the Notice of Opposition issued over two years before the Notice of Opposition was filed. *Shenzhen IVPS Tech.*, 2022 USPQ2d 1035, at *10-11 (finding that a plain copy of a registration that issued fewer than two months before the filing of the notice of opposition reflected the registration’s “current” status and title, but that plain copies of registrations that issued five or six years prior to the filing date did not).

Similarly, the printout of Opposer’s “About Us” page is not properly made of record by virtue of its submission with the Notice of Opposition. Except as provided in Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1) (involving copies of pleaded registrations showing current status and title), exhibits attached to a notice of opposition are not evidence on behalf of the party submitting them and must be properly identified and introduced in evidence during the testimony period. Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *see also* Trademark Trial And Appeal Board Manual of Procedure (TBMP) §§ 317 and 704.05(a) (June 2023). Thus, this exhibit submitted with the Notice of Opposition is not part of the evidentiary record.

(Reg. No. 4775882) (the “882 registration”).³ Opposer also pleads that “Opposer is the owner of a family of ‘BRAINY’ and ‘BRAINY BABY’ trademarks which it has been continuously using for over twenty (20) years” in connection with a variety of educational products.⁴

In her Answer, Applicant admitted that Opposer is the owner of the pleaded registrations,⁵ but otherwise denied the salient allegations of the Notice of Opposition.

The case is fully briefed. As plaintiff, Opposer bears the burden of proving its entitlement to a statutory cause of action and its Section 2(d) claim by a preponderance of the evidence. *See B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015) (“The party opposing registration bears the burden of proof, see § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b).”). As discussed more fully below, we find that Opposer has not met its burden of proof and therefore dismiss the opposition proceeding.

I. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application file.

³ Registration No. 4775882, issued on July 21, 2015; Sections 8 and 15 combined declaration accepted and acknowledged. The registration also covers goods in Classes 9 and 28, which are not relevant.

⁴ Notice of Opposition, para. 8 (1 TTABVUE 8).

⁵ Answer, paras. 2-7 (6 TTABVUE 2-3).

In addition, Opposer introduced the following testimony and evidence:

- Notice of Reliance on TSDR printouts of Opposer's pleaded registrations, together with TSDR printouts of additional BRAINY-inclusive marks registered to Opposer;⁶ and
- Oral Testimony Deposition of Dennis Fedoruk, the founder of Opposer, and related exhibits ("Fedoruk Test.").⁷

Applicant did not introduce any trial testimony evidence but did introduce the following evidence under a Notice of Reliance:⁸

- third-party registrations for BRAIN- and BRAINY-inclusive marks;
- an Internet article by Applicant titled, "Brainy Acts: Build Your Child's Brain for Success;"
- a dictionary definition of the term "Brainiac;" and
- a printout of a portion of Applicant's website at www.literacyblooms.com.

In rebuttal, Opposer introduced:

- Notice of Reliance on excerpts from the discovery deposition of Evelyn Williams English, Applicant in the present proceeding.⁹

⁶ 13 TTABVUE. The non-pleaded registered marks included in the Notice of Reliance are: BRAINY BABY (Reg. No. 2315020); BRAINY KIDS (Reg. No. 4643739); BRAINY BABY MUSIC (Reg. No. 4076205); THE BRAINY BABY LEARNING LIBRARY (Reg. No. 6442895); BRAINY BUGS (Reg. No. 6629947); BRAINY EXPLORERS (Reg. No. 6487542); BRAINYWORKS (Reg. No. 6590673); RIGHT BRAIN (Reg. No. 6423152); and LEFT BRAIN (Reg. Nos. 5903654, 5743654).

⁷ The public version of Mr. Fedoruk's testimony is at 16 TTABVUE, and the confidential version of his testimony is at 15 TTABVUE. Exhibits 1-19 (with the exception of Exhibit 18) to Mr. Fedoruk's testimony are available at 19 TTABVUE. Exhibit 18 to Mr. Fedoruk's testimony is filed separately: the redacted version is at 18 TTABVUE and the confidential version is at 17 TTABVUE.

⁸ 14 TTABVUE.

⁹ 20 TTABVUE.

II. Background

A. Opposer's Business and Marks

Dennis Fedoruk is the “owner, CEO, [or] president” of Opposer; his exact title depends on the corporate structure of Opposer, which has varied over time.¹⁰ Mr. Fedoruk began working on the concept of the BRAINY BABY mark around 1995.¹¹ The BRAINY BABY mark was developed first; now Opposer has “so many BRAINY marks,” including Opposer’s “very popular” BRAINY BABY RIGHT BRAIN and BRAINY BABY LEFT BRAIN marks, which are used with Opposer’s “flagship” video and book product lines.¹² Mr. Fedoruk testified that it was “easy” to come up with the different marks; “once you have the word BRAINY ... then you can, you know, fill in the blank.”¹³

According to Mr. Fedoruk, Opposer’s BRAINY-inclusive product line has expanded over its 25 years of operation, moving from baby, toddler and young child educational products, such as DVDS, books, games, puzzles, and flash cards,¹⁴ to BRAINY PETS for cats and dogs,¹⁵ and to non-learning products, such as cloth diapers, vitamins and nutraceuticals.¹⁶ Although prices for the different products sold

¹⁰ Fedoruk Test., p. 6, lines 12-17 (16 TTABVUE 8).

¹¹ *Id.* at 8, lines 19-25 (16 TTABVUE 10).

¹² *Id.* at 7, line 9 through p. 8, line 2 (16 TTABVUE 9-10).

¹³ *Id.* at 8, lines 7-11 (16 TTABVUE 10).

¹⁴ *Id.* at 13, lines 2-16 (16 TTABVUE 15).

¹⁵ *Id.* at 8, lines 15-17 (16 TTABVUE 10).

¹⁶ *Id.* at 32, lines 6-14 (16 TTABVUE 34).

under the BRAINY-inclusive marks vary, they range from about \$5 to \$30, but can be higher if more items are packaged as a set.¹⁷

B. Applicant's Business and Mark

Applicant, Evelyn Williams English, did not testify in this proceeding. By her application, she seeks to register the mark BRAINY ACTS for, among other things, activity books and flash cards.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *4-8 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Applicant does not dispute Opposer's entitlement to bring a statutory cause of action, or even address the matter at all in its briefing. Nonetheless, it is Opposer's burden to prove its statutory entitlement. To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, *2 (Fed. Cir. 2022) (citing *Lexmark Int'l, Inc. v. Static Control*

¹⁷ *Id.* at 32, lines 19-25 (16 TTABVUE 34).

Components, Inc., 572 U.S. 118, 129, 132 (2014)); *Corcamore*, 2020 USPQ2d 11277, at *4.

“[A] party that demonstrates a real interest in [oppos]ing a trademark under [Section 13 of the Trademark Act, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act]. . . . Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3].” *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, *17 (TTAB 2022) (quoting *Corcamore*, 2020 USPQ2d 11277, at *7).

Opposer properly made of record TSDR printouts showing the current status and title of its numerous pleaded registrations, together with TSDR printouts of its additional registered BRAINY-inclusive marks.¹⁸ Because Opposer’s registrations are of record, Opposer has established its statutory entitlement to bring a Section 2(d) claim that is not wholly without merit. *See Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

¹⁸ Opposer’s Notice of Reliance (13 TTABVUE). Specifically, the TSDR printout for the ’882 registration is at 13 TTABVUE 20-24.

A. Did Opposer Establish Its Claimed Family of Marks?

In its Notice of Opposition, Opposer alleges that it is the owner of a family of marks featuring BRAINY and BRAINY BABY as the family characteristic.¹⁹ In its briefing, however, Opposer argues only that it has established a family of marks having BRAINY (not BRAINY BABY) as the family feature.²⁰

With this in mind, we begin our likelihood of confusion analysis by determining whether Opposer's pleaded family of marks having BRAINY as the family feature has been proven. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, *6-7 (TTAB 2020). Proof of a family of marks under the ninth *DuPont* factor could be relevant in a likelihood of confusion dispute in at least one of two ways. First, it could affect the analysis of the similarity of goods. *New Era*, 2020 USPQ2d 10596, at *6 (citing *DuPont*, 177 USPQ at 567 ("(9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)"). Where a senior user employs a family of marks on a range of products, a junior user with a mark that has the family characteristic is less able to argue that the difference in the goods has significant weight, because consumers are accustomed to seeing the "family" on a range of goods. *New Era*, 2020 USPQ2d 10596, at *6. Second, where the family

¹⁹ Notice of Opposition, para. 8 (1 TTABVUE 8).

²⁰ Opposer's brief, p. 6 (21 TTABVUE 11) ("Consumers recognize [Opposer's registered] marks as originating from a common source because of the consistent use of the term 'BRAINY.'" Opposer also asserts, "Opposer's earliest mark within the BRAINY family pre-dates Applicant's filing date ..."); Opposer's reply brief, p. 1 (23 TTABVUE 5) (Applicant's arguments "[ignore] the very clear pattern established by Opposer's 'BRAINY' marks, specifically, 'BRAINY' alongside a companion term." (footnote omitted)).

comprises a common prefix in marks, a junior user may find it harder to argue that the difference in the ‘non-family’ part of its mark weighs against confusion because consumers are accustomed to seeing the family component together with other elements coming from one source (the senior user). *Id.*

Opposer’s reliance on a family of BRAINY marks presents a preliminary issue we must resolve before assessing likelihood of confusion. *Id.* The reason we must resolve it first is that one of the issues in an opposition is priority. Where an opposer relies on a registration, the priority issue is obviated by ownership of the registration. *See King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110-11 (CCPA 1974). *See also Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012). Although the USPTO may register several individual marks comprising a family characteristic together with one or more other elements, it does not register ‘families’ of prefixes, suffixes, or other components of a mark. Thus, an opposer relying on a family of marks is relying on common law rights in the alleged family. *New Era*, 2020 USPQ2d 10596, at *6-7.

The family of marks doctrine has been explained by the Court of Appeals for the Federal Circuit as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.... Recognition of the family is achieved when the pattern of usage of the common element

is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1891-92 (Fed. Cir. 1991) (citations omitted).

Neither the mere intention to create a family of marks, nor ownership of multiple registrations containing the family term, is sufficient in and of itself to establish that a party owns a family of marks. *New Era*, 2020 USPQ2d 10596, at *7; *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978).

In order to prove ownership of a family of marks, Opposer must first establish that prior to the entry into the field of Applicant's mark, the marks containing the claimed 'family' feature or at least a substantial number of them, were used and promoted together in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature. *New Era*, 2020 USPQ2d 10596, at *7. Second, Opposer must establish that the 'family' feature is distinctive, i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark. *Id.* (citing *Marion Labs. Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1218-19 (TTAB 1988)).

The burden of proving a family of marks falls with Opposer, the party asserting the existence of the family. *New Era*, 2020 USPQ2d 10596, at *7; *TPI Holdings Inc. v. TrailerTrader.com LLC*, 126 USPQ2d 1409, 1419 (TTAB 2018).

To support its position that it owns a family of marks featuring BRAINY as the common element, Opposer first points to its multiple registrations for BRAINY-

inclusive marks, including BRAINY BABY (Reg. Nos. 4,775,882; 4,002,221; and 2,315,020); BRAINY KIDS (Reg. Nos. 4,643,738; 4,643,739; and 4,643,740); RIGHT BRAIN (Reg. No. 6,423,152); and LEFT BRAIN (Reg. Nos. 5,903,654; and 5,743,654).²¹ However, as mentioned above, our case law is clear that multiple registrations for related marks is not sufficient in and of itself to establish a family of marks. *See e.g., Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1514 (TTAB 2009) (“The fact that opposer has used and registered several marks including SCHICK is not in itself sufficient to establish the existence of a family of marks.”); *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1204 (TTAB 2016) (evidence of many registrations “alone do not demonstrate the extent to which customers have been exposed to the marks”). Consequently, this argument is not persuasive.

As part of its case-in-chief, Opposer offered into evidence the testimony of Mr. Fedoruk, its founder, who testified about Opposer’s alleged family of marks. However, the phrasing of the question assumes the existence of the family, so the testimony naturally fails to establish it:

6 Q **And which Brainy marks – I understand there**
7 **is a family of Brainy marks.** Which mark did you come up
8 with first?

9 A Brainy Baby was the first one. Brainy Baby
10 clearly was the first mark we developed. It was mid
11 ’90s. ’95 I believe. And we intended to start with the
12 early ages first, the infant and preschool, and that’s
13 why we came up with Brainy Baby.

14 Q Okay. Perfect. Thank you.²²

²¹ Opposer’s brief, pp. 2-3, 5-6 (TTABVUE 8-9, 10-11).

²² Fedoruk Test., p. 7, lines 6-14 (16 TTABVUE 9) (emphasis added).

Opposer argues that Mr. Fedoruk's testimony and related Exhibits 3 and 4 support its family of marks argument as its family of marks has been widely advertised since 1995.²³ Exhibit 3 is a printout of Opposer's infomercial that is available on YouTube; however, the only pertinent mark this printout shows is BRAINY BABY: LEARNING FOR A LIFETIME.²⁴ Thus, this evidence showing a single mark fails to establish a family of marks.

Exhibit 4 is a collective exhibit consisting of the front covers of two magazines, select articles from those magazines, two different ads placed by Opposer in those magazines, a photocopy of Opposer's product catalog, and photocopies of other publication's mentioning Opposer's products, at least some of which were sent to Opposer by its clipping service.²⁵ Opposer clarifies in its reply brief that "Exhibit 4 provides examples of products offered under 'RIGHT BRAIN,' 'LEFT BRAIN,' and 'BRAINY BABY LEARNING LIBRARY' with dates of 2001, 2003, and 2004 (at SFB000004, SFB000010, SFB000049-51, SFB000055)[,]" which we address in turn.²⁶

First, documents bearing Bates Nos. SFB000004 (19 TTABVUE 70) and SFB000010 (19 TTABVUE 76) are actually part of Exhibits 11 and 12, respectively. Nonetheless, they are similar in that each is a printout of a DVD product description, and each shows the mark BRAINY BABY LEARNING LIBRARY in ordinary text at

²³ Opposer's brief, p. 11 (21 TTABVUE 16); Opposer's reply brief, p. 7 (23 TTABVUE 11).

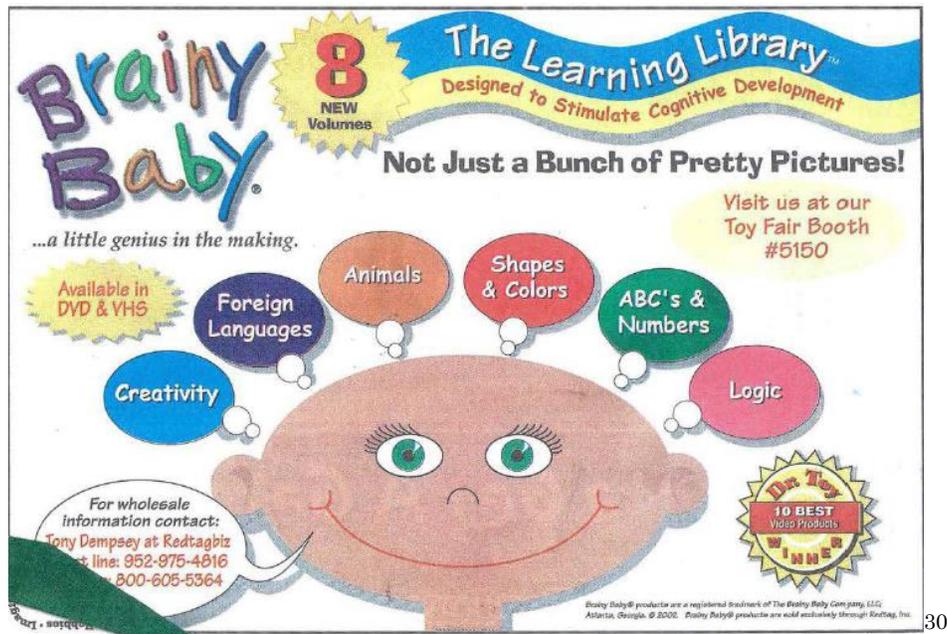
²⁴ Exhibit 3 (19 TTABVUE 7).

²⁵ Fedoruk Test., p. 20, line 2 through p. 21, line 23 (16 TTABVUE 22-23) and Exhibit 4 (19 TTABVUE 8-29).

²⁶ Opposer's reply brief, p. 7 (23 TTABVUE 11).

the top of the page.²⁷ In the middle of the page, under the header “Brand,” and spaced apart from the first mark appears the BRAINY BABY mark, also typed as ordinary text; BRAINY BABY also appears under the heading “Studio & Production Company”.²⁸ Much text about the DVD specification appears before and after each occurrence of the terms BRAINY BABY and their display in ordinary text – similar to the text surrounding them – causes the repetition of the terms (even assuming they appear as marks) to be lost on the viewer.²⁹ Thus, we find that these two exhibits are insufficient to show use of a family of marks.

Second, turning to documents bearing Bates Nos. SFB000049-51 of Exhibit 4, the most pertinent evidence consists of two different ads, one of which is shown below.



²⁷ 19 TTABVUE 70, 76.

²⁸ *Id.*

²⁹ *Id.*

³⁰ 19 TTABVUE 14.

The above ad shows the BRAINY BABY mark together with multiple DVD/VHS topics, such as animals, shapes and colors. The fact that the ad promotes “8 new volumes” does not constitute a family of marks.

The second ad, reproduced below, shows the BRAINY BABY mark at the top and contains an image of a grouping of Opposer’s videos at the bottom:

Brainy Baby
... a little genius in the making.™

The NEW face of early learning

2+2=4

Your child's education begins at birth. That's why the Brainy Baby® video series was created, to give your child a jump-start on learning. Every Brainy Baby® video features 45 minutes of solid educational content. Captivating real-life images and inspiring music will both entertain and educate your child. Start your child's education with a solid foundation. Start with Brainy Baby.®

Available in DVD & VHS

The Learning Library
Designed to Stimulate Cognitive Development

Winner of 10 NATIONAL AWARDS

1-877-455-BABY
www.brainybaby.com

© 2005 The Brainy Baby Co., LLC

Ages 8 months to 5 years

An educational video series that makes learning fun!

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³¹ 19 TTABVUE 15 (Bates No. SFB000051).

Here again, the ad only shows one mark, i.e., the BRAINY BABY mark, not a family of marks. The same identical mark BRAINY BABY appears in each instance on each video, albeit in connection with a different topic, such as ABCs, 123s, shapes and colors, and animals. As such, the mark BRAINY BABY is used with a series of DVDs; it does not show use of BRAINY as a feature of a family of marks.

Third, Opposer's product catalog, SFB000055, shown below, is also insufficient to establish a family of marks featuring BRAINY as the common characteristic:

The image shows a product catalog for BRAINY BABY DVDs. It features four distinct DVD titles, each with its own description and pricing. The titles are:

- Right Brain**: DVD #20019, SRP \$17.99. Description: "This video works together with the Left Brain video to present both creative and logical types of images and activities. Right Brain features classical music and gentle voices and explores Creative Thinking, Art & Imagination, Rhymes, and more! DVD includes special features such as: Baby Bloopers, Behind The Scenes, and Storybook. 45 minutes. For ages 9-24 months." The cover art shows a baby's face with various shapes and colors.
- Left Brain**: DVD #20029, SRP \$17.99. Description: "This video works together with the Right Brain video to present both creative and logical types of images and activities. Left Brain features classical music and gentle voices, and explores Logic, Patterns, Letters & Numbers, Sequencing, Analyzing details, and more! DVD includes special features such as: Baby Bloopers, Behind The Scenes, and Storybook. 45 minutes. For ages 9-24 months." The cover art shows a baby's face with various shapes and colors.
- Laugh & Learn**: DVD #20119, SRP \$17.99. Description: "This video introduces 'Things that Go', Matching Games, Music, Silly Faces, and more. Children are encouraged to use critical skills like Problem Solving, Listening Skills, Classifying Skills, and Concept Awareness. 45 minutes. For ages 1-3 years." The cover art shows a baby's face with various shapes and colors.
- Peek-A-Boo**: DVD #20109, SRP \$17.99. Description: "This video introduces such important skills as object permanence, communication, cause-and-effect, language basics and many others. Babies and toddlers will delight in eye-catching visuals, silly faces, rhymes and music, and lots of Peek-a-boo games! DVD includes special features such as: Baby Bloopers, Behind The Scenes, and Storybook. 45 minutes. For ages 1-3 years." The cover art shows a baby's face with various shapes and colors.

On the right side of the catalog, there is a vertical blue bar with the word "DVDs" and a television icon. At the bottom of this bar is a small circle containing the number "3".

SFB000055³²

³² Exhibit 4 to Fedoruk Test. (19 TTABVUE 19).

Even though Opposer has registered the marks BRAINY BABY RIGHT BRAIN, and BRAINY BABY LEFT BRAIN, the arrangement of these branded products on this page is insufficient to show that Opposer has advertised and promoted its products in such a way to establish a family of marks with BRAINY as the common feature.

In its reply brief, Opposer cites to certain exhibits that it contends evidence that Opposer has established a family of marks.³³ In addition to Exhibit 4 discussed above, Opposer points to Exhibits 1, 2, 5 and 10 to Mr. Fedoruk's testimony, each of which we address in turn.

Exhibit 1 is a screen capture of Opposer's website homepage, which contains the following images:



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³³ Opposer's reply brief, p. 10 (23 TTABVUE 14).

³⁴ Exhibit 1 (19 TTABVUE 2-3).

While it is true that these images show use of the BRAINY BABY mark in proximity to the words RIGHT BRAIN, these images are insufficient to establish BRAINY as the common element of a family of marks because only one BRAINY-inclusive mark is shown. To show a family of marks, the marks in the family must be advertised and promoted together so that a consumer could, upon seeing the different marks displayed together, understand that multiple marks include a common element.

Exhibit 2 is a printout of an early VHS product description.³⁵ This exhibit shows only the BRAINY BABY RIGHT BRAIN mark, not multiple marks advertised together, and similarly is insufficient to establish a family of marks.

Exhibit 5 similarly fails to establish a family of marks. It is a list of awards, a portion of which is reproduced below.³⁶ This list merely recites Opposer's products that have received an award and, while the title of the list incorporates the term BRAINY, the term otherwise appears infrequently on the page:

³⁵ Exhibit 2 (19 TTABVUE 4-5).

³⁶ Opposer's reply brief, p. 7 (23 TTABVUE 11); Exhibit 5 to the Fedoruk Test. (19 TTABVUE 30-31).

The Brainy Baby Company Awards List



<u>Award</u>	<u>Product</u>	<u>Year</u>
Dove Foundation Family Seal of Approval	ABC DVD	General
Dove Foundation Family Seal of Approval	Art DVD	General
Dove Foundation Family Seal of Approval	Shapes & Colors DVD	General
Dove Foundation Family Seal of Approval	BIQ World Around Us DVD	General
Dove Foundation Family Seal of Approval	Talking Hands DVD	General
Dr. Toy 100 Best Products	Natura Nativa Learning Media	2010
Baby&Children's Reader's Favorite	Brainy Baby Line	2009
Best of Suwanee	Baby's First Impressions Line	2009
iParenting Media Award	BIQ World Around Us CD	2009
Creative Child Magazine Seal of Excellence	4 Pack Books	2008
Creative Child Magazine Preferred Choice	BIQ Colors DVD	2008
Creative Child Magazine Seal of Excellence	Jingle Bells DVD	2008
Parenting Magazine Top 10 Videos	BIQ World Around Us DVD	2008
ToyMan Top Products Which Have What it Takes	Happy Hammy Toy	2007
ToyMan Top Products Which Have What it Takes	Logic Box Toy	2007
ToyMan Top Products Which Have What it Takes	Mini Music Maker Toy	2007
ToyMan Top Products Which Have What it Takes	Number Bug Toy	2007
ToyMan Top Products Which Have What it Takes	4-in1/Quad Book	2007
ToyMan Top Products Which Have What it Takes	Animal Wood Puzzle	2007
ToyMan Top Products Which Have What it Takes	Snap Cards Game	2007

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Last, in support of its family of marks argument, Opposer cites to Exhibit 10 to Mr. Fedoruk’s testimony, which is the “About Us” portion of Opposer’s website.³⁸ Opposer argues that this “About Us” page evidences its family of marks because it states that “the company has brought more than 200 Brainy Baby® products to market.”³⁹ Even assuming this is true, it is well-settled that it is not enough that Opposer merely offers multiple products under marks having a common element; they must be advertised in such a way that the family feature is perceived by consumers. *J & J Snack Foods*, 18 USPQ2d at 1891-92 (“Simply using a series of similar marks does not of itself establish the existence of a family.”).

³⁷ Exhibit 5 (19 TTABVUE 30).

³⁸ Opposer’s reply brief, pp. 7-8 (23 TTABVUE 11-12); Exhibit 10 (19 TTABVUE 64-65).

³⁹ Opposer’s reply brief, pp. 7-8 (23 TTABVUE 11-12); Exhibit 10 (19 TTABVUE 64-65).

In sum, we find that Opposer has failed to demonstrate the existence of its alleged family of marks featuring BRAINY as the common characteristic of the family.⁴⁰ The evidence does not establish that a family of marks has been consistently promoted or advertised together in such a manner to cause consumers to recognize the common feature. Consequently, the ninth *DuPont* factor is neutral.

“Having determined that Opposer failed to prove prior use of a family of [BRAINY] marks, priority and likelihood of confusion must be based on each of Opposer’s pleaded marks separately.” *New Era*, 2020 USPQ2d 10596, at *9.

B. Priority and Likelihood of Confusion Analysis Based on Opposer’s ’882 Registration

We resume our priority and likelihood of confusion analysis, assessing the similarity of Applicant’s mark to Opposer’s pleaded marks individually. We focus the likelihood of confusion analysis on the mark that is considered closest to Applicant’s mark and goods, namely, the BRAINY BABY mark of the ’882 registration, which identifies “Children’s activity books; Children’s books; Children’s interactive educational books,” in International Class 16. *See, e.g., In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If we find a likelihood of confusion as to this mark, we need not find it as to Opposer’s other registered marks; conversely, if we do not

⁴⁰ Given Opposer’s failure to prove that it has advertised and used its marks as a family, we need not reach the issue of whether the word BRAINY is sufficiently distinctive to serve as the surname for a family of marks, as alleged by Applicant (Applicant’s brief, pp. 12-15 (22 TTABVUE 17-20)). *See, e.g., Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1338 n.1 (TTAB 2006).

find a likelihood of confusion with this mark, then we would not find it as to Opposer's other registered marks for the goods identified therein.

1. Priority

Because Applicant has not counterclaimed to cancel Opposer's pleaded '882 registration, priority is not at issue with respect to this registered mark and the goods identified in it. *Nkanginieme v. Appleton*, 2023 USPQ2d 277, *4 (TTAB 2023) (citing *King Candy*, 182 USPQ at 110).

2. Analysis of the *DuPont* Factors

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *DuPont*, 177 USPQ at 567 (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider the likelihood of confusion factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, *14 (TTAB 2023) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994,

2020 USPQ2d 10341, *3 (Fed. Cir. 2020); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

a. Similarity or Dissimilarity of the Marks

First we consider the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567; *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs*, 101 USPQ2d at 1721. The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *See e.g., Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic

that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

The parties’ marks are similar in appearance to the extent that both marks share the term BRAINY. Turning to pronunciation, Applicant’s mark sounds similar to the known word “brainiacs,” the definition of which is of record.⁴¹ Thus, Applicant’s mark, when pronounced, sounds like one word, “brainiacs.” In contrast, Opposer’s mark sounds like two distinct words; moreover, its use of alliteration causes the mark to have a lilting cadence, which consists not only of the initial “b” sound, but also the repetition of the long “a” sound, overall giving it a pleasing—but very different— sound when pronounced.

In terms of connotation, Applicant argues that its mark “creates a double meaning referring to a ‘brainiac’ an intelligent person, and actions that parents and families can include in their daily teaching and learning routines to build the brain, encourage language growth, and advance understanding about fundamental literacy.”⁴² Opposer counters that “[Applicant’s argument] ignores the very clear pattern established by Opposer’s ‘BRAINY’ marks, specifically, ‘BRAINY’ alongside a companion term.”⁴³ However, since we find that Opposer failed to establish it owned a family of marks, this argument is not persuasive. Opposer’s remaining argument is

⁴¹ Exhibit C to Applicant’s notice of reliance (14 TTABVUE 83).

⁴² Applicant’s brief, p. 3 (22 TTABVUE 8).

⁴³ Opposer’s reply brief, p. 1 (23 TTABVUE 5).

that because the goods are identical, less similarity between the marks is required to find that there is a likelihood of confusion.⁴⁴

Considering the marks in their entireties, we find that the marks are dissimilar. Applicant's and Opposer's marks are similar only to the extent that they each contain the term BRAINY and connote that using their respective identified goods will result in a smart child. Overall, however, the marks are dissimilar due to their significant differences in pronunciation and commercial impression due to Applicant's use of a play on words compared to Opposer's use of alliteration.

Thus, the first *DuPont* factor weighs against a likelihood of confusion.

b. The Strength or Weakness of the Mark of Opposer's '882 Registration

We turn now to the fifth and sixth *DuPont* factors, which consider "the strength of the prior user's mark as a central factor in the likelihood of confusion analysis." *Spireon, Inc. v. Flex LTD*, 2023 USPQ2d 737, *3-4 (Fed. Cir. 2023) ("Two of the *DuPont* factors (the fifth and sixth) consider strength."). The fifth *DuPont* factor enables Opposer to prove that its pleaded mark is entitled to an expanded scope of protection by adducing evidence of "[t]he fame of the prior mark (sales, advertising, length of use);" the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of "[t]he number and nature of similar marks in use on similar goods." *DuPont*, 177 USPQ at 567.

⁴⁴ *Id.* at 1-2 (23 TTABVUE 5-6).

i. Commercial Strength or Fame of Opposer's Mark

Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source. *New Era*, 2020 USPQ2d 10596, at *10 (citing *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006)). Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. *New Era*, 2020 USPQ2d 10596, at *10. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). “[L]ikelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). In placing Opposer’s mark on that spectrum, our “applicable viewpoint is that of the relevant market,” not that of the general public. *Id.* (citing *Palm Bay Imps.*, 73 USPQ2d at 1694).

Because Opposer claims that its mark is “famous,”⁴⁵ and because of the wide latitude of legal protection we accord a famous mark, and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to clearly prove the fame of its pleaded mark. *Coach Servs.*, 101 USPQ2d at 1720.

⁴⁵ Opposer’s brief, p. 11 (21 TTABVUE 16); Opposer’s reply brief, p. 5 (23 TTABVUE 9).

Commercial strength or fame “may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods.” *Made in Nature*, 2022 USPQ2d 557, at *31; *Weider Pubs., LLC v. D & D Beauty Care Co., LLC*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014). *See also Bose Corp.*, 63 USPQ2d at 1303.

Opposer argues that its mark falls on the high end of the fame spectrum because of Opposer’s long use, strong sales, robust advertising and promotional efforts, unsolicited media recognition, and industry awards,⁴⁶ all of which we discuss in turn.

(a) Length of Use of the Mark with “Children’s Books”

According to Opposer’s brief, Mr. Fedoruk, Opposer’s founder, testified that Opposer has used its BRAINY BABY mark for over 25 years and that this long use is evidence of the mark’s fame.⁴⁷ While we find that the mark was first used in 1995 with VHS tapes, it is not clear when the mark was first used with “children’s activity books; children’s books; children’s interactive educational books,” which are identified in the ’882 registration, as Mr. Fedoruk testifies only vaguely that they were launched “from there”:

⁴⁶ Opposer’s brief, pp. 11-12 (21 TTABVUE 16-17).

⁴⁷ *Id.* at 11 (21 TTABVUE 16).

Q And when that business was launched in 1995,
1 what products were sold under the Brainy marks?

2 A We had a variety of marks. Immediately the
3 first thing that was launched was the DVD since I had a
4 film background and a television studio to work with and
5 a staff to help prepare those. DVD -- excuse me. It
6 was back then was VHS. Wasn't even DVD, right? We
7 refer to DVDs now as, you know, that's the commonplace.
8 But we were talking VHS back in those days. DVDs came a
9 little bit later around 2000.
10 But we started off with video material, video
11 programming, **and then from there it launched into books**
12 and puzzles, games, flashcards, an entire family of
13 products, even plush toys. Anything that was
14 educational. A lot of paper product. Anything that you
15 would find in a school curriculum you would find as part
16 of our Brainy Baby set.⁴⁸

Additionally, Opposer's counsel showed Mr. Fedoruk the '882 certificate of
registration and had him read the dates of first use into the record:

3 Q You can see that okay? Can you tell me what
4 this document is?

5 A That looks like a registration certificate for
6 Brainy Baby.

7 Q And can you please read to me what it says
8 here as well in the highlighted portion.

9 A First use September 18, 2003.⁴⁹

This is not probative evidence of first use because the witness is merely reading the
information on the certificate of registration into the record. It is well-settled that a
date of use of a mark made in a registration is not evidence in the proceeding on

⁴⁸ Fedoruk Test., p. 12, line 25 through p. 13, line 16 (16 TTABVUE 14-15) (emphasis added).

⁴⁹ *Id.* at 11, lines 3-9 (16 TTABVUE 13).

behalf of the registrant and must be established by competent evidence, properly adduced at trial. 37 C.F.R. § 2.122(b)(2) (“The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.”); TBMP § 704.04 (2023) and cases cited therein. *Cf. Baseball Am., Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1848, n.10 (TTAB 2004) (dates of use in application not evidence of such use). Opposer did not independently establish the dates of first use based on Mr. Fedoruk’s personal knowledge or on other records kept in the ordinary course of business.

In sum, we find that Opposer has not established its date of first use, and hence the length of use of Opposer’s mark on the goods identified in the ’882 registration.

(b) Marketing and Advertising Efforts

Opposer also argues that its mark is famous because of Opposer’s robust advertising and marketing efforts over the course of 25 years.⁵⁰ According to Mr. Fedoruk, from the launch of Opposer’s business in 1995 through about 2005, Opposer advertised by “major television commercials” and via infomercial.⁵¹ Opposer posted its infomercial to YouTube.com and printed out the YouTube.com page for the record; it is dated 2017, but Mr. Fedoruk testified that he did not know if that was the date the video was posted or the date of production.⁵² The infomercial was professionally

⁵⁰ Opposer’s brief, p. 11 (21 TTABVUE 16).

⁵¹ Fedoruk Test., p. 18, lines 1-7 (16 TTABVUE 20) and Exhibit 3 (19 TTABVUE 7).

⁵² Fedoruk Test., p. 19, lines 14-19 (16 TTABVUE 21) and Exhibit 3 (19 TTABVUE 7).

made, and Opposer spent “more than probably 3-, 4-, \$500,000” on it and broadcast it nationwide.”⁵³ Additionally, Mr. Fedoruk testified about “one of [Opposer’s] biggest advertisement[s]”, which was “the appearance on QVC channel twice,” which “was a huge event for us,” because “somewhere around a hundred million people watch that program at any given time.”⁵⁴

Mr. Fedoruk testified that Opposer placed advertisements in “major magazines,” such as Parent magazine and Parenting magazine; full page ads in those magazines cost about \$100,000 per full page.⁵⁵ He also testified that Opposer attended “probably 12 to 18 trade shows per year,” which includes “the prestigious New York Toy Fair [which Opposer attended] 13 years in a row.”⁵⁶ Opposer also attended other trade shows, such as the National School Supply and Equipment (NSSEA) tradeshow, the Juvenile Products Manufacturing Association (JPMA) tradeshow, the National Association for the Education of Young Children (NAEYC) tradeshow, the Mothers of Preschoolers (MOPs) tradeshow, and the American Specialty Toy (ASTRA) tradeshow, plus “many gift shows.”⁵⁷

⁵³ Fedoruk Test, p. 18, lines 2-7 (16 TTABVUE 20).

⁵⁴ *Id.* at 44, lines 3-8 (16 TTABVUE 46).

⁵⁵ *Id.* at 18, lines 8-10 (16 TTABVUE 20) and Exhibit 4 (19 TTABVUE 8-15).

⁵⁶ *Id.* at 18, lines 11-13 (16 TTABVUE 20).

⁵⁷ *Id.* at 18, lines 13-20 (16 TTABVUE 20).

Mr. Fedoruk testified that Opposer was “very, very heavy” into all forms of advertising and marketing but all that changed when social media became popular, and that social media is Opposer’s focus now because it “is much easier.”⁵⁸

(c) Retail Sales Activities

Mr. Fedoruk testified that when Opposer first launched, i.e., in the mid-1990s, i.e., before the Internet, it relied on direct to consumer sales.⁵⁹ Later, Opposer’s products were picked up by retail stores, and “[r]etail took off wildly.”⁶⁰ “Within a year,” Opposer was “in all specialty stores throughout the country. And then it launched into mid tier stores such as Toys ‘R’ Us, [and] Walmart.”⁶¹ Mr. Fedoruk testified that Opposer was “the number two brand in Toys ‘R’ Us” for about “12 or 14 years until they ceased operations.”⁶² “But then when Amazon came along, of course [Opposer] migrated into the e-commerce channels and then the whole distribution grew even larger.”⁶³

Currently, Opposer sells only online.⁶⁴ Mr. Fedoruk testified that this was by design: “[w]e strategically pulled out of retail many years ago, and that was part of our marketing strategy to make our product a little more scarce in the marketplace,”

⁵⁸ *Id.* at 18, lines 21-25 (16 TTABVUE 20).

⁵⁹ *Id.* at 13, lines 19-20 (16 TTABVUE 15).

⁶⁰ *Id.* at 13, line 24 (16 TTABVUE 15).

⁶¹ *Id.* at 13, line 24 through 14, line 3 (16 TTABVUE 15-16).

⁶² *Id.* at 14, lines 4-6 (16 TTABVUE 16).

⁶³ *Id.* at 14, lines 13-15 (16 TTABVUE 16).

⁶⁴ *Id.* at 27, lines 13-14 (16 TTABVUE 29).

which allows demand to build up; then, according to Mr. Fedoruk's testimony, Opposer intends to reintroduce its products into the retail market at a later time.⁶⁵ Consequently, Opposer is now only on "its own Shopify sites, amazon.com, walmart.com, [and] a few other major e-commerce sites."⁶⁶ Opposer plans to relaunch its products in 2022 and 2023, which Mr. Fedoruk testified means that Opposer intends to "reintroduce the brand through some partnerships with Target ... and a few other stores that we're in discussions with and relaunch it selectively back into the marketplace, along with a product line expansion for education and other types of related products."⁶⁷

Mr. Fedoruk testified that throughout the last "15, 20 years historically Brainy Baby has had gross revenues of over \$30 million when we were in retail."⁶⁸ Now that Opposer is selling online only, "it's probably closer to three quarters of a million dollars, \$750,000, in just online sales." Opposer's testimony is unclear, however, in that there is no indication if these gross revenue amounts are per year or per a different time frame. For example, it could be that Opposer's historical gross revenues cover the entire period from initial launch through Opposer's move to social media. In view of the lack of clarity, we are left to guess.

⁶⁵ *Id.* at 27, lines 14-20 (16 TTABVUE 29).

⁶⁶ *Id.* at 27, line 22 through 28, line 5 (16 TTABVUE 29-30).

⁶⁷ *Id.* at 27, line 23 through 28, line 5 (16 TTABVUE 29-30).

⁶⁸ Opposer's brief, p. 12 (21 TTABVUE 17) (citing Fedoruk Test., p. 37, lines 11-14 (16 TTABVUE 39)).

Over its decades of operation, Opposer has accumulated over seventy awards, some of which are listed in Opposer's Exhibit 5.⁶⁹ Opposer has also collected many testimonials, some of which are set out in Exhibit 6.⁷⁰ While the awards and the testimonials mention the brand BRAINY BABY, many specifically address Opposer's video series; few specifically mention the goods of the '882 registration. Further, some testimonials refer to Opposer's "tools" or "educational products," however, this is too vague to be probative, as this broadly describes almost all of Opposer's products, some of which are identified in its other pleaded registrations.

Mr. Fedoruk testified that Opposer has entered into multiple licensing arrangements, and he described some examples of them, generally identifying the parties to the agreement and the agreement's purpose.⁷¹ To corroborate Mr. Fedoruk's testimony, Opposer made of record a number of confidential financial documents, including some license agreements, account statements, and amendments and addenda to agreements.⁷² These documents range in date from 2007-2014. While these documents corroborate generally Mr. Fedoruk's testimony that Opposer was engaged in licensing activities from 2007-2014, there is otherwise no context for or explanation about these agreements, nor is there any indication of their current status, i.e., expired, renewed, etc. Moreover, some of the documents on

⁶⁹ *Id.* at 23, lines 6-16 (16 TTABVUE 25) and Exhibit 5 (19 TTABVUE 30-43).

⁷⁰ Exhibit 6 (19 TTABVUE 44-51).

⁷¹ Fedoruk Test., p. 37, line 19 through p. 40, line 18 (16 TTABVUE 39-42).

⁷² Exhibit 18 (17 TTABVUE).

their face involve activities outside the United States,⁷³ so they are not probative of the fame of the mark in the United States.

**(d) Conclusions about the Fame of Opposer's
Mark of the '882 Registration**

Overall, the evidence and Mr. Fedoruk's testimony supports the conclusion that Opposer runs a commercially successful business, but given the unclear, imprecise nature of Opposer's testimony, the evidence does not support a finding that Opposer's mark falls on the higher end of the spectrum of fame. *See, e.g., Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1902 (Fed. Cir. 1989) (fame of NINA RICCI mark for fragrance products supported by \$ 350 million in retail sales between 1981 and 1986); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (fame of HUGGIES mark for diapers supported by over \$ 300 million in sales in a single year). In short, we find that Opposer has failed to show that its mark is entitled to an expanded scope of protection.

To the extent that Opposer contends that its reduced current gross sales revenues support its position that its mark is famous, Opposer would need to provide evidence of its market share or market ranking that would place its current raw sales revenues in context. Without context, Opposer's current raw gross sales revenues do not support a finding that its mark falls on the higher end of the spectrum of fame. *Fossil*

⁷³ See for example, 17 TTABVUE 45 (licensed territory is outside the United States) and 17 TTABVUE 20, 47 (account statements for sales outside the United States). Mr. Fedoruk also testified that one of the entities identified in the account statement was outside the United States. Fedoruk Test., p. 38, lines 2-7 (16 TTABVUE 40).

Inc. v. Fossil Grp., 49 USPQ2d 1451, 1457 (TTAB 1998) (“Raw sales and advertising figures unless they are extraordinarily large, which is not the case with opposer’s FOSSIL products are simply not sufficient by themselves to establish that the mark is famous.”); *see also Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007) (raw numbers alone in today’s world may be misleading). *Cf. AutoZone Parts, Inc. v. Dent Zone Cos.*, 100 USPQ2d 1356, 1361-62 (TTAB 2011) (“We recognize that petitioner has not placed its sales and advertising figures in context.... However, we do not believe that is necessary here in view of the volume of sales and advertising expenditures and the fact that petitioner’s advertising reaches over 90% of the U.S. population numerous times each year.”).

We appreciate that both of Opposer’s QVC appearances reached a very wide audience.⁷⁴ However, Opposer failed to introduce any evidence regarding the number of potential consumers who may have viewed its infomercial or its advertisements in Parenting magazine (in 2003) and Parent magazine (in 2004). Because Opposer failed to introduce these figures, we cannot gauge the number of potential consumers who may have been exposed to the mark. *Made in Nature*, 2022 USPQ2d 557, at *39 (“Opposer did not provide the volume and geographic extent of the readership of the articles and other media in which Opposer’s MADE IN NATURE brand was recognized.”).

⁷⁴ Fedoruk Test., p. 44, lines 3-8 (16 TTABVUE 46).

Also troubling, while the record shows that one of Opposer's appearances on QVC was in 2010,⁷⁵ there is no evidence as to the second appearance. Similarly, the record does not indicate specifically when or how often the infomercial aired. Because Mr. Fedoruk testified that "[i]n the very beginning[, i.e., the] early ages of '95 to 2005 roughly we did major television commercials we did infomercials[.]"⁷⁶ we presume that the infomercial aired and the second QVC appearance was made prior to the company's move to social media, and presumably at least the bulk of these efforts were prior to 2005. As such, this infomercial and QVC appearance evidence, together with the appearance of Opposer's mark in two sporadic issues of Parent and Parenting magazines almost 20 years ago, is not, without more, sufficient to establish that its mark is currently famous or commercially strong. Similarly, the remaining unsolicited media excerpts⁷⁷ proffered by Opposer are also not current, as two are dated 2005, and the other lacks a date.⁷⁸

Although Opposer has moved to advertising and promoting its mark exclusively via social media, Opposer did not make of record any evidence of its current social media presence, apart from a one-page printout from YouTube.com where it has posted its infomercial. Apart from this, the record is devoid of evidence of the actual social media platforms where Opposer can be found, its number of posts, its number of followers, or any evidence of the success of its current social media campaigns, for

⁷⁵ Exhibit 18 to Fedoruk Test. (17 TTABVUE 16).

⁷⁶ Fedoruk Test., p. 18, lines 2-4 (16 TTABVUE 20).

⁷⁷ Exhibit 4 to Fedoruk Test. (19 TTABVUE 27-29).

⁷⁸ *Id.* (19 TTABVUE 27-29).

example. Further, Opposer did not make of record any testimony or documentary evidence of its current social media advertising expenditures, nor do we know how much money is currently spent specifically advertising the goods identified in the '882 registration offered under the mark, or the success of any social media campaign specifically directed to these goods.

ii. Conceptual Strength of the BRAINY BABY Mark of the '882 Registration

Because the mark of the '882 registration is registered on the Principal Register without a claim of acquired distinctiveness, the mark is presumed to be inherently distinctive and at least suggestive. *Monster Energy*, 2023 USPQ2d 87, at *20; *Tea Bd. of India*, 80 USPQ2d at 1889.

Applicant, seeking to diminish the conceptual strength of Opposer's mark, made of record forty-two third-party registrations for BRAIN- and BRAINY-inclusive marks, which Applicant contends "indicate the suggestive significance of the words 'brain' and 'brainy'."⁷⁹ Opposer seeks to discredit this evidence, arguing:

all but eight of the third-party marks are variations using the term "BRAIN," **not** "BRAINY" (the term used by both Applicant and Opposer). The eight marks utilizing "BRAINY" either cover different goods, are no longer active, or include a distinguishing term within the mark that designates the source. Further, three of the cited registrations have been cancelled.⁸⁰

"Third-party registrations alone may be relevant, in the manner of dictionary definitions, 'to prove that some segment of the [marks] has a normally understood

⁷⁹ Applicant's brief, p. 9 (22 TTABVUE 14).

⁸⁰ Opposer's reply brief, p. 8 (23 TTABVUE 12).

and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *New Era*, 2020 USPQ2d 10596, at *12 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 , 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)). Even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

As an initial matter, we agree with Opposer that to the extent that any of the third-party registrations have been cancelled, they have no probative value, and we give them no further consideration.⁸¹ *Made in Nature*, 2022 USPQ2d 557, at *26; *Anthony’s Pizza & Pasta Int’l, Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1277 n.32 (TTAB 2009), *aff’d*, 415 F. App’x 222 (Fed. Cir. 2010).

Next, we find evidence of BRAIN-inclusive marks to be of little probative value as Applicant did not make any argument or submit any evidence demonstrating how these marks make commercial impressions similar to BRAINY-inclusive marks. *Made in Nature*, 2022 USPQ2d 557, at *28-29. We thus afford, for example, the following third-party registrations little probative value: BRAINPREP for “[p]rinted materials, namely, workbooks, textbooks, and instructors’ guides for standardized

⁸¹ The following registrations are cancelled: BRAINWELL (Reg. No. 4,947,364); BRAINY BOP (Reg. No. 4999208); BRAINY KIT and Design (Reg. No. 4,928,848). 14 TTABVUE 54, 61, 63.

test preparation” (Reg. No. 5365237);⁸² and KIDZBRAINTOYS for on-line retail store services covering educational toys (Reg. No. 6,604,238).⁸³

Opposer’s BRAINY BABY mark is registered for “Children’s activity books; Children’s books; Children’s interactive educational books.” Applicant introduced evidence of third-party registrations for BRAINY-inclusive marks for various educational services. Although Applicant did not introduce any evidence or make any argument that educational services are related to the goods identified in Opposer’s ’882 registration, we find that such services are closely related. In fact, educational services and printed matter, such as books (or printable matter in the case of on-line educational services), are so often offered by the same providers that the USPTO includes several preapproved identifications in its Identification Manual referencing the two together, the following of which is representative:⁸⁴

- Educational services, namely, conducting {indicate specific modes of instruction, e.g., classes, seminars, conferences, workshops} in the field of {indicate specific field, e.g. pet care, math, tax preparation} and distribution of course materials in connection therewith in **printed** or electronic format
- Educational services, namely, conducting informal on-line programs in the fields of {indicate subject matter or field of programs}, and printable materials distributed therewith

⁸² 14 TTABVUE 57.

⁸³ 14 TTABVUE 7. Applicant’s evidence contains additional deficiencies to the extent that some of the third-party registrations are not based on use in commerce, but rather were issued under Trademark Act Sections 44(e) or 66(a), 15 U.S.C. §§ 1126(e) or 1141f(a). *Made in Nature*, 2022 USPQ2d 557, at *25-26 (excluding marks registered under Section 44 or Section 66 from consideration of conceptual strength). This includes, for example BRAINCANDO (Reg. No. 5701842) available at 14 TTABVUE 19.

⁸⁴ See Appendix A attached hereto.

Therefore, we consider the following third-party marks to be most probative:

- GO BRAINY for “[e]ducational services namely providing workshops and exhibits, and conducting programs all in the fields of science, history, law, personal development, and subjects related thereto, exclusive of problem solving approaches and strategies” (Reg. No. 3035722).⁸⁵
- BRAINY DAYS for “[e]ducational services, namely, providing online instruction in the field of language arts and visual arts” (Reg. No. 5330823).⁸⁶
- BRAINY BYTES for “[e]ducational services, namely, providing 1st through 12th grade classroom instruction for children involving computers” (Reg. No. 6016000).⁸⁷
- BRAINY ALLEY for, among other services, “[e]ducational services, namely, providing classes and workshops in the fields of creative recreation and arts” (Reg. No. 3388541).⁸⁸
- A MARILYN BURNS BRAINY DAY BOOK and Design for children’s books that teach mathematical skills (Reg. No. 1920882).⁸⁹
- BRAINYVERSE for kits comprising printed instructional, educational, and teaching materials for educational activities in the field of science, technology, engineering and math education (Reg. No. 6681892).⁹⁰
- BRAINY TOYS FOR KIDS OF ALL AGES for mail and telephone catalog order services for activity kits comprising printed educational materials for use in teaching creative thinking skills, problem solving skills, logic and math skills (Reg. No. 2602028).⁹¹

⁸⁵ 14 TTABVUE 74.

⁸⁶ 14 TTABVUE 42.

⁸⁷ 14 TTABVUE 53.

⁸⁸ 14 TTABVUE 76.

⁸⁹ 14 TTABVUE 79-80.

⁹⁰ 14 TTABVUE 73.

⁹¹ 14 TTABVUE 77.

We take judicial notice that the term BRAINY is defined as “intelligent; smart.”⁹² Considering the dictionary definition of the term and the above third-party registrations, we find that Opposer’s BRAINY BABY mark is highly suggestive because it connotes the purpose of Opposer’s children’s books, i.e., to stimulate brain development in babies to promote intelligence. *See Am. Lebanese Syrian Assoc. Charities, Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1029 (TTAB 2011) (“Cure4Kids” when used in connection with “medical and scientific research in the field of children’s health” and “fund raising in support of funding research into cures for childhood diseases” is highly suggestive of the purpose of the fund raising and medical research (i.e., to cure children)).

iii. Commercial Weakness

Evidence that the public is confronted with significant use by others of similar marks for similar goods tends to indicate a lack of commercial strength. *DuPont*, 177 USPQ at 567. “The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of ... similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)).

⁹² The American Heritage Dictionary, accessed in July 27, 2023. <https://www.ahdictionary.com/word/search.html?q=brainy>.

Applicant argues that the “co-existing [third-party] registrations ... serve as evidence that ‘brain’ and ‘brainy’ are commonly used to suggest intelligence, especially in connection with education products and services, so that the public will look to other elements to determine source where marks share this term.”⁹³ However, as Opposer recognizes, Applicant did not make any evidence of use of these third-party marks of record.⁹⁴ Third-party registrations are “not evidence of what happens in the marketplace or that customers are familiar with them.” *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), *quoted in In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1735 (TTAB 2018).⁹⁵ Moreover, Opposer effectively demonstrated that third-party BRAINY-inclusive marks are not in use through its deposition of Applicant, Evelyn English, who was questioned on this topic:

Q As you sit here today, you can't name
5 any product that has a brand name that includes
6 the word "brainy" in the field of childhood
7 education; is that correct?

8 A I could not. I could not.⁹⁶

We find this testimony evidence is probative of the lack of third-party uses of BRAINY-inclusive marks on competing, pertinent goods.

⁹³ Applicant's brief, p. 9 (22 TTABVUE 14).

⁹⁴ Opposer's reply brief, p. 8 (23 TTABVUE 12).

⁹⁵ According to *Spireon*, registrations for identical marks and identical goods are evidence of commercial use unless Opposer proves they are not in use. *Spireon*, 2023 USPQ2d 737, at *7 (“This case presents the far narrower question of whether the burden of showing non-use of identical marks for identical goods rests with the opposer. We think it necessarily does.”). The evidence in this case does not include such registrations.

⁹⁶ English deposition, p. 69, lines 4-7 (20 TTABVUE 15).

iv. Summary of the Strength or Weakness of Opposer's Mark of the '882 Registration

Opposer has not proven that its mark is currently famous or commercially strong, nor was Applicant successful in demonstrating that Opposer's mark is commercially weak. Accordingly, we find that Opposer's registered BRAINY BABY mark falls in the middle of the commercial strength spectrum from very strong to very weak. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734. That said, Opposer's mark is highly suggestive for "children's activity books; children's books; children's interactive educational books" and therefore, has some conceptual weakness. For this reason, we find that Opposer's mark is entitled to a relatively narrow scope of protection. *See, e.g., Juice Generation*, 115 USPQ2d at 1675 (highly suggestive marks are entitled to a narrower scope of protection than more fanciful marks).

c. Identity of Goods; Trade Channels and Classes of Consumers

Turning to the second *DuPont* factor, we compare the goods at issue. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant's involved application and Opposer's '882 registration. *See, e.g., Stone Lion*, 110 USPQ2d at 1162; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). We also assess the third *DuPont* factor involving "the similarity or dissimilarity of

established, likely-to-continue trade channels” for the involved goods, *DuPont*, 177 USPQ at 567, and the classes of consumers of the goods.

The application’s identification of goods includes “activity books ... in the field of early childhood development,” which is encompassed by “children’s activity books” as identified in Opposer’s ’882 registration. Consequently, the parties’ goods are legally identical in part. *New Era*, 2020 USPQ2d 10596, at *13 (“Caps,” as identified in the application, is broad enough to encompass all types of caps, including the “athletic caps” identified in Opposer’s registration; “[t]hus, on their face, Applicant’s and Opposer’s goods are in-part legally identical.”); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

Because the goods are legally identical in part and unrestricted as to channels of trade, we must presume that these particular goods travel in the same ordinary trade and distribution channels and will be marketed to the same classes of potential consumers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *New Era*, 2020 USPQ2d 10596, at *13 (“Because the goods are in-part identical and unrestricted as to trade channels, we must also presume that these particular goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers.”).

d. Conditions Under Which and Buyers to Whom Sales Are Made

The fourth *DuPont* factor assesses the “conditions under which and buyers to whom sales are made i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Opposer argues that its products are inexpensive, making them susceptible to impulse purchasing and that, as a result, this factor weighs in favor of Opposer.⁹⁷ Mr. Fedoruk testified Opposer’s books are about \$10-\$30 each, depending on their size.⁹⁸ There is no record evidence of the price or expected price of Applicant’s identified goods, nor does Applicant specify one in its brief, arguing instead that this factor “is of minimal importance based on the differences in the marks and weakness of the shared terms.”⁹⁹

We must presume that the identified goods include “all goods of the type identified, without limitation as to their nature or price,” *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, *8 (TTAB 2020), including goods that are relatively inexpensive. “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Id.* (quoting *Recot*, 54 USPQ2d at 1899).

Thus, the fourth *DuPont* factor weighs in favor of a likelihood of confusion.

⁹⁷ Opposer’s brief, pp. 10-11 (21 TTABVUE 15-16).

⁹⁸ Fedoruk Test., p. 35, lines 6-25 (16 TTABVUE 35) and Exhibit 16 (19 TTABVUE 94-99).

⁹⁹ Applicant’s brief, p. 6 (22 TTABVUE 11).

e. Evidence of Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the parties' subject marks. *DuPont*, 177 USPQ at 567. These factors are interrelated.

“[T]he absence of evidence of actual confusion, under the seventh du Pont factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth du Pont factor, that there has been a significant opportunity for actual confusion to have occurred.” *In re Ass'n of the U.S. Army*, 85 USPQ2d 1264, 1273 (TTAB 2007) (citing *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992)).

Here, the parties agree that there is no evidence of actual consumer confusion.¹⁰⁰

Applicant's involved application is based on intent-to-use. As there is no evidence that Applicant has used her mark yet, we cannot conclude that there has been an appreciable opportunity for actual consumer confusion to have occurred. Consequently, the fact there has been no evidence of actual confusion in this context is not probative. Accordingly, we find the seventh and eighth *DuPont* factors to be neutral.

¹⁰⁰ Opposer's brief, p. 12 (21 TTABVUE 17); Applicant's brief, p. 11 (22 TTABVUE 16).

f. Remaining *DuPont* Factors

Opposer argues that the remaining factors 8-13 are not applicable to this case.¹⁰¹ To the extent that Applicant addressed these factors,¹⁰² her arguments have already been addressed in connection with other factors. Apart from the ninth factor regarding the family of marks, which we addressed earlier, we agree that there is no record evidence relating to them and find that these factors are neutral.

g. Balancing the *DuPont* Factors

Opposer was not successful in establishing that its mark falls on the higher end of the spectrum of fame, nor was Applicant successful in diminishing the commercial strength of Opposer's mark. That said, we find that Opposer's mark is conceptually weak and entitled to a relatively narrow scope of protection. Considering the marks in their entirety, we find that the marks are dissimilar. The marks are similar only to the extent that they each incorporate the term BRAINY and to the extent that they each connote that using the identified goods will result in a smart child; however, the marks are dissimilar due to their significant differences in pronunciation and commercial impression due to Applicant's use of a play on words compared to Opposer's use of alliteration, especially when considered in light of the highly suggestive nature of Opposer's mark. Although the parties' goods are legally identical in part, the channels of trade and classes of consumers are presumed to be the same,

¹⁰¹ Opposer's brief, p. 12 (21 TTABVUE 17).

¹⁰² Applicant's brief, pp. 11-17 (22 TTABVUE 16-22).

and the parties' goods may be subject to impulse purchasing, overall, we find the marks sufficiently dissimilar to avoid a likelihood of confusion.

V. Decision

The opposition to registration of the BRAINY ACTS mark in Application Serial No. 90160993 is dismissed.

VI. APPENDIX A

041-1766	041	Educational services , namely, conducting (indicate specific modes of instruction, e.g., classes, seminars, conferences, workshops) in the field of (indicate specific field, e.g. pet care, math, tax preparation) and distribution of course materials in connection therewith in printed or electronic format	X	07/10/2014	SERVICES	On 08-25-2011, this 12-17-2009 entry was deleted because see more >	10-2014
041-757	041	Educational services , namely, conducting informal on-line programs in the fields of (indicate subject matter or field of programs), and printable materials distributed therewith	A	08/24/2006	SERVICES		08-2002
041-1459	041	Educational services , namely, conducting informal programs in the fields of (indicate subject matter or field of programs), using on-line activities and interactive exhibits, and printable materials distributed therewith	X	07/25/2013	SERVICES	On 08-25-2011, this 08-24-2006 entry was deleted because see more >	10-2013

